

REMARKS

Claims 1-32, 41-48, 63-86, 88, and 91 are pending in the present application.

In the office action mailed July 27, 2005 (the "Office Action"), the Examiner rejected claims 1-28, 41-48, 63, 64, 67-71, 76, 78, 80, 82, 84, 86, 88, and 91 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,731,301 to Sato (the "Sato patent"). Claims 29-32 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Sato patent in view of U.S. Patent No. 6,501,483 to Wong *et al.* (the "Wong patent").

The Sato patent is not prior art under 35 U.S.C. 102(e) because the inventions of at least claims 1, 14, 23, 27, 41, 42, 63, 64, 70, 86, 88, and 91 were conceived prior to the effective prior art date of the Sato patent and were diligently reduced to practice thereafter.

The effective prior art date of the Sato patent is March 26, 2001, its U.S. filing date. Although the Sato patent claims the benefit of an earlier filed Japanese patent application, under *In re Hilmer*, the 35 U.S.C. 102(e) date for the Sato patent is nevertheless its U.S. filing date. *See In re Hilmer*, 359 F.2d 859 (C.C.P.A. 1966); Manual of Patent Examining Procedure 706.02(f)(1)(I)(D) and 706.02(f)(1)(II), Example 3 (8th ed., Revision No. 2) ("MPEP"); MPEP 715(III)(A).

A declaration under 37 C.F.R. 1.131 by the co-inventors James R. Peterson, Robert H. Mullis, and Gregory M. Hunter (the "131 Declaration") has been provided to establish conception of the claimed invention prior to the March 26, 2001 filing date of the Sato patent, and due diligence in constructively reducing the invention to practice by filing the present application on March 30, 2001.

As provided in the 131 Declaration, the co-inventors received a draft of the patent application that was filed on March 30, 2001, by correspondence dated March 23, 2001. The draft patent application reviewed by the co-inventors included a description and drawings of the subject matter claimed in at least claims 1, 14, 23, 27, 41, 42, 63, 64, 70, 86, 88, and 91 of the present application. Conception of the claimed invention prior to March 26, 2001 is demonstrated by the draft patent application that was provided to the co-inventors for their review in correspondence dated March 23, 2001. The critical period in which diligence must be shown begins just prior to March 26, 2001, the 102(e) date for the Sato patent, and ends with March 30, 2001, constructive reduction to practice of the present invention. *See* MPEP 715.07(a). Due diligence from just before March 26, 2001 to March 30, 2001 is demonstrated by

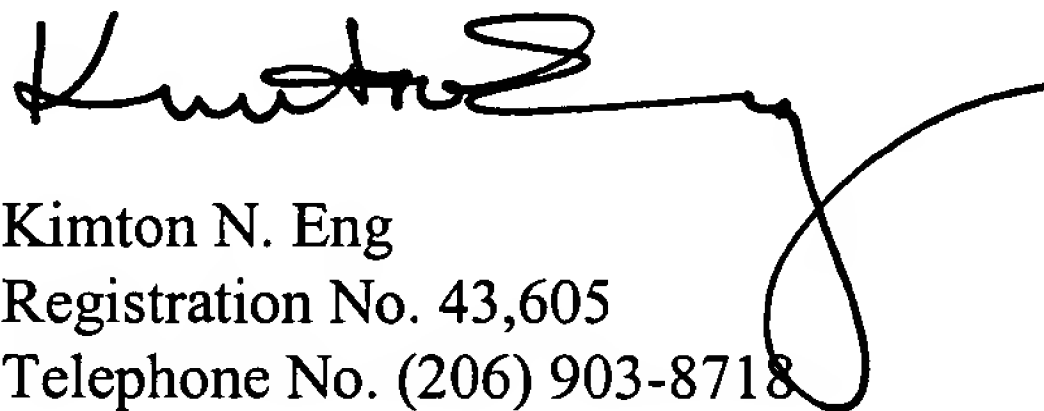
the co-inventors' review of the draft patent application and provision of comments to the undersigned on March 27, 28, and 29, 2001 following their review. A final version of the patent application was filed on March 30, 2001, one week after the March 23, 2001 correspondence providing the co-inventors with a draft of the patent application for their review.

By establishing conception of the claimed invention prior to March 26, 2001, and reduction to practice thereafter linked by due diligence, the Sato patent cannot be used as prior art in the present application. As a result, the rejection of claims 1-28, 41-48, 63, 64, 67-71, 76, 78, 80, 82, 84, 86, 88, and 91 under 35 U.S.C. 102(e) as being anticipated by the Sato patent cannot be maintained, and consequently, must be withdrawn. Similarly, with respect to the rejection of claims 29-32 under 35 U.S.C. 103(a) as being unpatentable over the Sato patent in view of the Wong patent, the obviousness rejection must also be withdrawn because, as previously discussed, the Sato patent cannot be used as prior art in the present application.

All of the claims pending in the present application are in condition for allowance. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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Enclosures:

Postcard

Check

Fee Transmittal Sheet (+ copy)

Declaration under 37 C.F.R. § 1.131

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